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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,074	03/15/2001	John M. Hall	10004376-1	9131

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Intellectual Property Administration
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EXAMINER

CLARK, ISAAC R

ART UNIT PAPER NUMBER

2154

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/810,074	Applicant(s) HALL ET AL.	
	Examiner Isaac R Clark	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/01/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-21 are presented for examination.

Priority

2. The effective filing date for the subject matter in the pending claims in this application is 03/15/2001.

Response to Amendment

3. Applicant's arguments filed 11/01/2004 have been fully considered but they are not persuasive.
4. As per claims 1-21, applicant argues that Biliris et al. (US 2001/0009017, "Biliris") and Dieterman (US 6,393,464) as cited in the previous office action do not teach the limitation "determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory." Applicant points out that this limitation is included in all 3 independent claims (Claims 1, 15, and 18), and that suggests that claims 1-21 are patentable over the cited prior art.
5. The examiner respectfully traverses this argument. In addition, it is respectfully submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Art Unit: 2154

6. Biliris teaches using a query to retrieve lists of email addresses from an organization database using a declarative addressing scheme (Paragraphs 0041,0003, and 0009). Biliris explicitly retrieving subsets of lists from the database, one of ordinary skill in the arts would understand that a query could request the list of every employee in the company and rather than every employee of the company that resided in New Jersey. Addresses found on the list would represent internal addresses.

7. Dieterman teaches using a list of email addresses and determining whether the destination email addresses on a set of emails match an email address on the list of addresses (Abstract, Fig. 3 block 33; col. 4, lines 31-38).

8. One of ordinary skill in the art would recognize that generating a list of internal address as taught by Biliris and making the determination taught by Dieterman would result in determining whether an email was addressed to an internal address.

9. The examiner maintains the rejections from the previous office action. These rejections are repeated below for the Applicant's convenience.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2154

11. Claims 1-9, 12, and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biliris et al. (US 2001/0009017) hereinafter Biliris in view of Dieterman (US 6,393,464).

12. As per claim 1, Biliris teaches a method of identifying whether a communication in a computer network is directed to a destination that is internal to a company, the computer network including a directory server 114, the directory server including a company directory that provides employee information 120 (Fig. 1; Paragraphs 0034 and 0043), the method comprising:

receiving destination information associated with a first network communication (Fig. 2B block 252, Paragraph 0031); and

accessing the directory server and comparing the received destination information with information in the company directory (Paragraph 0035; query database using an email address).

13. Biliris fails to teach determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory.

14. Dieterman teaches determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory (Fig. 3 block 33; col. 4, lines 31-38; directory includes all company addresses, addresses found in directory are internal).

Art Unit: 2154

15. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Biliris and Dieterman to use the comparison of the received destination information and the information in the company directory to determine whether the main was directed to a destination internal to the company because they both deal with specifying addresses for outgoing email.

Furthermore, the teaching of Dieterman to determine whether the email address is present in a directory would allow email directed to external addresses to be subject to a separate approval process (Dieterman, col. 2 lines 35-39).

16. As per claim 2, Biliris fails to teach the method of claim 1 further comprising adding an identifier to the first network communication to indicate whether the first network communication is directed to at least one destination external to the company.

17. Dieterman teaches adding an identifier to the first network communication to indicate whether the first network communication is directed only to destinations internal to the company (col. 5, lines 3-10).

18. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Biliris and Dieterman to add an identifier to the first network communication to indicate whether the first network communication is only to destinations internal to the company because they both deal with specifying addresses for outgoing email. Furthermore, the teaching of Dieterman to add an identifier to the first network communication to indicate whether the first network communication is only to destinations internal to the company would facilitate sending

Art Unit: 2154

out messages which do not require approval without delay (Dieterman, col. 5, lines 19-22).

19. As per claim 3, Biliris teaches the method of claim 1, wherein the destination information specifies at least one email address (Paragraph 0034, 0035; example of a declarative address including an email address).

20. As per claim 4, Biliris in view of Dieterman as applied to claim 3 teaches all of the elements of claim 4.

21. As per claim 5, Biliris teaches the method of claim 1, wherein the destination information specifies at least one fax phone number (Paragraphs 0022, invention applicable to faxes; Paragraph 0034, any contact attribute may be used).

22. As per claim 6, Biliris in view of Dieterman as applied to claim 5 teaches all of the elements of claim 6.

23. As per claim 7, Biliris teaches the method of claim 1 wherein the destination information specifies a plurality of destinations (Paragraph 0034; filters may be concatenated using logical operators; Paragraph 0035; filters may contain email addresses);

24. Biliris fails to teach that the method further comprises :

identifying whether each of the plurality of destinations is internal to the company based on a comparison of the received destination information and the information in the company directory.

25. Dieterman teaches identifying whether each of the plurality of destinations is internal to the company based on a comparison of the received destination information

Art Unit: 2154

and the information in the company directory (Fig 4. blocks 71 and 72; col. 4, line 67; col. 5, lines 1-5).

26. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Biliris and Dieterman to identify whether each of the plurality of destinations is internal to the company based on a comparison of the received destination information and the information in the company directory because they both deal with specifying addresses for outgoing email. Furthermore, the teaching of Dieterman to identify whether each of the plurality of destinations is internal to the company based on a comparison of the received destination information and the information in the company directory would allow making the decision of whether a message was internal or external when the message was addressed to multiple recipients (Dieterman, col. 4 lines 3-6).

27. As per claim 8, Biliris fails to teach the method of claim 7 further comprising:
adding an identifier to the first network communication to indicate whether the first network communication is directed only to destinations internal to the company.

28. Dieterman teaches adding an identifier to the first network communication to indicate whether the first network communication is directed only to destinations internal to the company (col. 5, lines 3-10).

29. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Biliris and Dieterman to add an identifier to the first network communication to indicate whether the first network communication is only to destinations internal to the company because they both deal with specifying

Art Unit: 2154

addresses for outgoing email. Furthermore, the teaching of Dieterman to add an identifier to the first network communication to indicate whether the first network communication is only to destinations internal to the company would facilitate sending out messages which do not require approval without delay (Dieterman, col. 5, lines 19-22).

30. As per claim 9, Biliris fails to teach the method of claim 7 further comprising:

adding an identifier to the first network communication to indicate whether the first network communication is directed to at least one destination external to the company.

31. Dieterman teaches adding an identifier to the first network communication to indicate whether the first network communication is directed to at least one destination external to the company (col. 5, lines 3-10).

32. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Biliris and Dieterman to add an identifier to the first network communication to indicate whether the first network communication is directed to at least one destination external to the company because they both deal with specifying addresses for outgoing email. Furthermore, the teaching of Dieterman to add an identifier to the first network communication to indicate whether the first network communication is directed to at least one destination external to the company would facilitate having an approval authority authorize messages intended for external distribution (Dieterman, col. 4 lines 58-63; Fig. 9).

33. As per claim 12, Biliris teaches the method of claim 1, wherein the directory server is an LDAP server (Paragraph 0027).

34. As per claim 15, claim 15 is rejected for the same reasons as claim 1.

35. As per claim 16, Biliris teaches the network device of claim 15 further comprising a memory coupled to the controller, the memory storing a destination identification process, and wherein the controller is configured to determine whether the destination information specifies a destination that is internal to a first company based on the destination identification process. The memory coupled to the computer and storing the destination identification process is not explicitly taught by Biliris, however Biliris does teach that the destination process may be a module in a computer system that is coupled to the controller (Paragraphs 0022 and 0025). Memory for storing the destination identification process during execution is an inherent part of the computer system.

36. As per claim 17, claim 17 is rejected for the same reasons as claim 8.

37. As per claim 18, claim 18 is a product claim containing the same subject matter as claim the method in 1. Claim 18 is rejected for the same reason as claim 1.

38. As per claim 19, claim 19 is a product claim containing the same subject matter as claim the method in 2. Claim 19 is rejected for the same reason as claim 2.

39. As per claim 20, claim 20 is a product claim containing the same subject matter as claim the method in 3. Claim 20 is rejected for the same reason as claim 3.

40. As per claim 21, claim 21 is a product claim containing the same subject matter as claim the method in 4. Claim 21 is rejected for the same reason as claim 4.

Art Unit: 2154

41. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biliris et al (US 2001/0009017) hereinafter Biliris in view of Dieterman (US 6,393,464) further in view of Arnold (US 6,275,848).

42. As per claim 10, Biliris fails to teach the method of claim 7 further comprising:
transmitting at least a portion of the first network communication via email to destinations identified as external to the company; and
transmitting at least a portion of the first network communication to a web server.

43. Arnold teaches the method of claim 7 further comprising:
transmitting at least a portion of the first network communication via email to destinations identified as external to the company (col. 4, lines 19-24)
transmitting at least a portion of the first network communication to a web server (col. 4, lines 19-22).

44. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Biliris and Arnold because they both involve email communications. Furthermore, the teaching of Arnold to transmit a portion of a network communication for external destinations and to transmit a portion to a web server would increase the efficiency of the transmission of large email messages by only transmitting attachments at the request of the recipients of the messages (Arnold, col. 2. lines 48-55).

45. As per claim 11, Biliris in view of Dieterman, further in view of Arnold fails to teach the method of claim 10, and further comprising:

transmitting an email communication to destinations identified as internal to the company, the email communication including link information for accessing the information transmitted to the web server.

46. Arnold teaches transmitting an email communication to destinations identified as internal to the company, the email communication including link information for accessing the information transmitted to the web server (col. 2 lines 34-37).

47. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Biliris and Arnold to transmit an email communication to destinations identified as internal to the company, the email communication including link information for accessing the information transmitted to the web server because they both deal with transmission of information via email communications. Furthermore, Arnold teaches that transmitting an email communication to destinations identified as internal to the company, the email communication including link information for accessing the information transmitted to the web server allows managing access to the attachment if the information in the link is designated as confidential (col. 2, lines 56-61).

48. Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Biliris et al (US 2001/0009017) hereinafter Biliris in view of Dieterman (US 6,393,464) further in view of Shaw et al. (US 6,247,045) hereinafter Shaw.

49. Biliris in view of Dieterman as applied to claim 7, fails to teach the method of claim 7 further comprising:

transmitting a first version of the first network communication to destinations identified as internal to the company; and

transmitting a second version of the first network communication to destinations not identified as internal to the company, the second version differing in content from the first version.

50. Shaw teaches the method of claim 7 further comprising:

transmitting a first version of the first network communication to destinations identified as internal to the company; and transmitting a second version of the first network communication to destinations not identified as internal to the company, the second version differing in content from the first version (col. 6, lines 4-13; different messages constructed based on designations of groups of users).

51. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Biliris and Shaw to transmit different versions of a network communications to destinations internal and external to the company because they both deal with addressing email communications to groups of users. Furthermore, the teaching of Shaw to transmit different versions of a network communications to destinations internal and external to the company would alleviate the tedium of having to manually generate separate messages for internal and external users (col. 2, lines 3-5).

52. Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Biliris et al (US 2001/0009017) hereinafter Biliris in view of Dieterman (US 6,393,464) further in view of Joseph et al. (US 5,761,415) hereinafter Joseph.

53. Biliris in view of Dieterman as applied to claim 7, fails to teach the method of claim 7 further comprising:

transmitting a version of the first network communication via a first communication method to destinations identified as internal to the company; and

transmitting a version of the first network communication via a second communication method to destinations not identified as internal to the company, the second communication method differing from the first communication method.

54. Joseph teaches the method of claim 7 further comprising:

transmitting a version of the first network communication via a first communication method to destinations identified as internal to the company (col. 4, lines 10-16; internal messages sent over the LAN); and

transmitting a version of the first network communication via a second communication method to destinations not identified as internal to the company, the second communication method differing from the first communication method (col. 4, lines 37-44; external communications sent by remote email via smtp server).

55. It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teachings of Biliris and Joseph because they both deal with fax or email communications. Furthermore, the teaching of Joseph to transmit messages to external clients using different means than that used for internal clients results in a communications system that can accommodate recipients who cannot be reached using the internal communications system even though the internal and

external recipients are contained in the same distribution list (Joseph, col. 4. lines 45-52).

Conclusion

56. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents and publication are cited to further show the state of this art with respect to "System and method for identifying internal and external communications in a computer network

- i. US 2002/0078158 A1 Brown et al.
- ii. US 2003/0046421 A1 Horvitz et al.

57. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

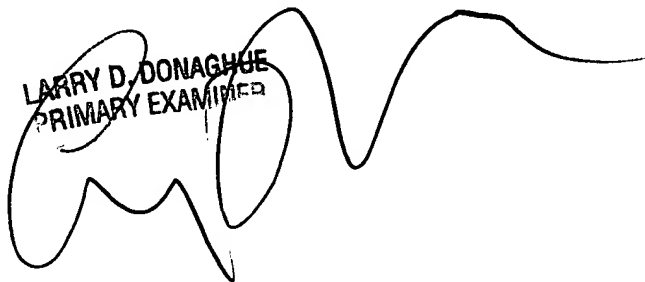
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac R Clark whose telephone number is (571)272-3961. The examiner can normally be reached on Monday-Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on (571)272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IRC

LARRY D. DONAGHUE
PRIMARY EXAMINER

A large, stylized handwritten signature in black ink, appearing to be 'LDD', is written over the printed name and title of the examiner.